



01-02-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #73

UNITED STATE PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application
Serial No. 76-380736

Published in the O.G. of October 8, 2002 at TM 596

E. & J. GALLO WINERY,

Opposer,

v.

CERVECERIA CENTROAMERICANA,
S.A.

Applicant.

Opposition No.

NOTICE OF OPPOSITION

E. & J. Gallo Winery, a corporation organized and existing under the laws of the State of California, believes that it will be damaged by the registration of the trademark shown in Applicant Serial Number 76-380736 filed March 8, 2002, and hereby opposes registration of same.

As grounds for opposition, Opposer by its attorney, Paul W. Reidl, respectfully shows and alleges as follows:

1. Opposer is a corporation organized and existing under the laws of the State of California with its principal place of business at 600 Yosemite Boulevard, Modesto, California 95354.

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2. At all times here mentioned Opposer has been actively engaged in the production, distribution and sale of wines and other goods in the United States under the trademark and trade name GALLO.

3. Opposer owns all rights in and to, among others, the federal trademark registrations listed below, each of which is valid and subsisting, uncanceled and unrevoked:

<u>TRADEMARK</u>	<u>REG. NO.</u>	<u>ISSUE DATE</u>	<u>GOODS</u>
GALLO	444,756	3-24-53	Wines
ERNEST & JULIO GALLO	778,837	10-20-64	Wines
GALLO	887,959	03/17/70	Meats/cheese
GALLO	891,339	5-19-70	Wines and Champagnes
GALLO	1,319,587	02/12/85	Meats/cheese
GALLO	1,650,478	7-09-91	Corkscrews
JULIO R. GALLO	1,813,967	12-28-93	Wines
ERNEST GALLO	1,815,078	1-4-94	Wines
GALLO SONOMA	1,911,682	8-15-95	Wines
GALLO OF SONOMA	2,231,215	3-9-99	Wines
GALLO	2,320,063	2-20-00	Clothing

4. The term "Gallo" means "rooster" in the Italian and Spanish languages. Opposer has, therefore, used rooster symbology on its labels, its advertising, and its logos. Opposer owns all rights in and to, among others, the federal trademark registrations listed below, each of which is valid and subsisting, uncanceled and unrevoked:

<u>TRADEMARK</u>	<u>REG. NO.</u>	<u>ISSUE DATE</u>	<u>GOODS</u>
(Rooster crest design)	838,504	11/7/1967	Wines
(Two roosters design)	2,159,050	5/19/1998	Wines

5. The GALLO family of marks and rooster designs were first used by Opposer in 1933. By virtue of the extensive use and promotion of its GALLO mark, and the widespread sale of its alcoholic beverages under the GALLO mark, the trademark and trade name GALLO and the rooster designs have come to be recognized throughout the United States as identifying goods finding their origin in or otherwise associated with Opposer. As a further result of Opposer's use and marketing efforts, and of the widespread recognition of the GALLO mark, this mark has become famous.

6. Opposer first began using the GALLO trademark and trade name in 1933 when Ernest and Julio Gallo founded the company. The GALLO trademark and trade name has been used continuously since that time. Opposer has sold billions of bottles of wine throughout the United States bearing the GALLO trademark and has spent over \$600,000,000 promoting it. Goods bearing the GALLO trademark are sold and promoted to retail consumers nationwide via all available media, including television and radio. They are also heavily promoted, sold and displayed in restaurants and other food service establishments. The GALLO trademark has a high degree of consumer recognition and in the United States stands exclusively for goods made or licensed by Opposer. Courts have

held without exception that the GALLO trademark is extraordinarily strong and is entitled to the broadest possible protection.¹

7. Opposer has vigorously protected its trademark against third party infringement and dilution and has stopped others from using its marks on a wide variety of goods and services, including: habanero sauce, salsa, beer, mezcal, cheese, wine, rice, coffee bags, shoes, sportswear, t-shirts, caps, bar towels, tote bags, jeans, jackets, canned vegetables, pasta, pickled jalapeño peppers, garlic butter, olive oil, dinnerware, tobacco products, toys, potato chips, hosiery, ties and related products, the naming of thoroughbred race horses, playing cards, board games, confetti, poker chips, compact discs, stereo equipment, drafting tables, women's coats, men's hats, cigars, ceramics, veterinary products, sauces, socks and scarves, pasta, and as domain names for web sites. That enforcement program has preserved the effectively exclusive connection between the GALLO trademark and Opposer.

8. Applicant is a large brewery in Guatemala. Applicant's house mark is GALLO. Its label features a stylized rendition of a rooster.

9. In 1970, Applicant attempted to sell its GALLO brand of beer in the United States. Opposer objected, and Applicant abandoned its plans. In 1979, Applicant attempted to sell its GALLO brand of beer in the United States. Opposer objected, and Applicant abandoned its plans. In 1980, Applicant applied to register the trademark GALLO for beer in Class 32. The examiner cited Opposer's GALLO mark against the

¹ Those cases include *E. & J. Gallo Winery v. Spider Webs Ltd.*, 129 F.Supp. 2d 1033 (S.D. Tex. 2001), *affirmed*, 2002 U.S. App. LEXIS 5928 (5th Cir. 2002); *E. & J. Gallo Winery v. Pasatiempos Gallo, S.A.*, 905 F.Supp. 1403 (E.D. Cal. 1994); *E. & J. Gallo Winery v. Consorzio del Gallo Nero*, 782 F.Supp. 457 (N.D. Cal. 1991); *E. & J. Gallo Winery v. Gallo Cattle Company*, 12 U.S.P.Q.2d 1657 (E.D. Cal. 1989), *affirmed*, 967 F.2d 1280 (9th Cir. 1992).

application, and Applicant abandoned it.

10. Applicant thereupon began selling beer in the United States under a FAMOSA label but began promoting it as a GALLO product. Opposer objected, and Applicant ceased running the ads. It continued selling its FAMOSA label using the rooster design.

11. The mark herein opposed comprises the word GALLITO. The term means “little rooster” in the Spanish language. The principal and dominant feature of the mark, “GALL___”, is similar to the principal and dominant feature of Opposer’s famous GALLO mark. The marks are similar in sight, sound, meaning and appearance. The goods for which the applied-for mark is intended for use according to the application identification are beer, ale and porter, mineral and carbonated water, etc. These are precisely the kinds of products which are closely associated with the Opposer's GALLO mark. In the normal course of trade, Opposer's goods and applicant's goods would be purchased by the same purchasers in the same channels of trade and would be marketed and promoted in the same channels. Accordingly, consumers would inevitably be lead to mistakenly believe that applicant's GALLITO products originate, are sponsored by, or are affiliated with Opposer.

12. The GALLO trademark was distinctive and famous long before Applicant adopted it. Opposer has used the GALLO trademark for nearly 70 years and has spent over \$600,000,000 promoting it. The GALLO trademark is well known to consumers, the trade, and Applicant. The GALLO brand stands uniquely for goods produced or licensed by Opposer.

13. The registration of Applicant's mark for the goods recited in the application would be inconsistent with Opposer's rights in its trade name and in its marks, will dilute the distinctiveness of Opposer's marks, and will cause damage to Opposer.

WHEREFORE, it is respectfully prayed that this opposition be sustained and that the mark which is the subject of Serial No. 76-380736 be denied registration.

The opposition fee in the sum of \$300.00 is filed herewith.

Dated: Modesto, California
December 27, 2002

E. & J. GALLO WINERY

By Paul W. Reidl
Paul W. Reidl
600 Yosemite Boulevard
Modesto, California 95354
(209) 341-4733



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E. & J. GALLO WINERY

600 Yosemite Boulevard
P. O. Box 1130
Modesto, California 95354



Paul W. Reidl
Associate General Counsel
Legal Department

Tel: (209) 341-4733
Fax: (209) 341-6270
Email: Paul.Reidl@ejgallo.com

December 27, 2002

VIA EXPRESS MAIL

Box TTAB
FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: **E. & J. Gallo Winery - Notice of Opposition**

Dear Sir:

Enclosed is an original and one copy of a Notice of Opposition signed by E. & J. Gallo Winery, as Opposer, to be filed against Cerveceria Centroamericana, S.A. Also enclosed is a \$300.00 check to cover the fee for filing the opposition.

Thank you for your attention to this matter.

Sincerely,

Paul W. Reidl

"Express Mail" mailing label number: **EF 276204066 US**

Date of Deposit: December 30, 2002

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office To Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Name: Bill [Signature]

12.30.02